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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09 865,942	05 25 2001	Wilson Tam	CL1253 USDIV	7909

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WILMINGTON, DE 19805

EXAMINER

TRUONG, DUC

ART UNIT	PAPER NUMBER
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1711

DATE MAILED: 03 20 2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/865,942

Applicant(s)
Tam et al.

Examiner
Duc Truong

Art Unit
1711



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on _____.
- 2a) This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-21 and 34-62 is/are pending in the application.
 - 4a) Of the above, claim(s) 35-62 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11-21 and 34 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 - a) All b) Some* c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- | | |
|---|---|
| 15) Notice of References Cited (PTO-892) | 18) Interview Summary (PTO-413) Paper No(s). |
| 16) Notice of Draftsperson's Patent Drawing Review (PTO-948) | 19) Notice of Informal Patent Application (PTO-152) |
| 17) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449, Paper No(s) <u>3</u>) | 20) Other |

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Applicant's election with traverse of Group I in Paper No. 5 is acknowledged. The traversal is on the ground(s) that the claims in Groups I and II require common elements and do not require an additional search. This is not found persuasive because the search is based on different reactants of Groups I and II and constitute an undue burden in that the search for group I does not involve a search of group II and no error in the reasons for the requirement have been pointed out by Applicant.

The requirement is still deemed proper and is therefore made FINAL.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 11-21 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Minagawa '298 of record on 1449.

The reference discloses a polymeric composition comprising reactions of 2-ortho alkylhydroxybenzylpropane-1,3-diol with a phosphorylating agent (see col. 20, lines 13 et seq.) Such as phosphorus trichloride (see col. 19, lines 45 et seq.) Under cited conditions (see col. 25, lines 62 onto col. 32).

Note that the propanediols comprising at least one ortho-alkylhydroxybenzyl group at the 2-position of the 1,3-propanediol structure and a second ortho-alkylhydroxybenzyl group can also be present at the same 2-position. (See col. 10, lines 32-45). Since said diols contains an aromatic

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group (a benzyl radical) and a diol, then said diols can be read on the claimed aromatic diol.

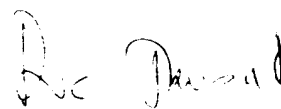
Further, said diols can contain an hydroxyl group and a diol group (two hydroxyl radical), the another diols can be considered as a polyhydric alcohol of the claims. (See col. 14, lines 35 et seq.).

The disclosure of the reference differs from the instant claims in that it does not disclose two specific reactants: a polyhydric alcohol and an aromatic diol to combine with phosphorus chloride. However, said polyhydric alcohol and said aromatic diol are included in the broad ortho-alkylhydroxybenzylpropane diol of the reference with different alkyl groups then it would have been obvious to one of ordinary skill in the art to select the polyhydric alcohol and the aromatic diol from the reference within the limitations of the instant claims since they have been shown to be effective in a similar system and thus would have been expected to provide adequate results. There is no showing of unexpected results derived from said selections.

Any inquiry concerning this communication should be directed to Duc Truong at telephone number (703) 308-2437.

Duc Truong

March 19, 2002



DUCTRUONG
PRIMARY EXAMINER